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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,470	07/18/2006	Tim Jungkamp	12810-00322-US1	4266

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EXAMINER

KOSACK, JOSEPH R

ART UNIT	PAPER NUMBER
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1626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,470	Applicant(s) JUNGKAMP ET AL.	
	Examiner Joseph R. Kosack	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-20 are pending in the instant application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 11, 2010 has been entered.

Claim 16 belongs to a previously withdrawn group and is withdrawn by the Examiner under 37 CFR 1.142(b) as being drawn to a non-elected invention.

Previous Claim Rejections - 35 USC § 103

Claims 1-10 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Drinkard et al. (USPN 3,356,748) in view of Fischer et al. (USPN 6,242,633) and Jungkamp et al. (WO 02/26698).

The Applicant has traversed the rejection on the grounds that the amended claims are not rendered obvious by the prior art, that the claims were found novel and with inventive step during the international phase, that Drinkard et al. does not suggest the pressures in the claims and is antiquated, and that the prior art does not teach the desirability of making the changes.

The Examiner respectfully disagrees. The amendment to the claims add pressure ranges ranging from 0.1 mbar to 100 bar for each of the distillation steps. The

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range of pressures claimed would cover everything from vacuum distillation, distillation at standard pressure (around 1 bar), to about 100 times standard pressure. These pressures were suggested by Jungkamp et al. (1 to 500 kPa, which translates to about 10 mbar to about 5 bar) which teach how to distill the products apart from one another. The distillation steps are working in a similar fashion between the instant claimed invention and the disclosure of Jungkamp et al.

In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Finally, even though the claims were not found to lack novelty or inventive step during the international phase, the Applicant is reminded that the decision of the international authority is not binding on the U.S. Patent and Trademark Office. The instant rejection contains references which were not cited during the international phase, and therefore the analysis is different during the national phase of the PCT application.

As the references of the prior art show the different steps of the process and the steps perform the same functions as that known in the prior art, the rejection is maintained.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10 and 17-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Drinkard et al. (USPN 3,356,748) in view of Fischer et al. (USPN 6,242,633) and Jungkamp et al. (WO 02/26698).

The claims are drawn to a process for preparing 3-pentenenitrile by isomerizing 2-methyl-3-butenitrile over a catalyst and distilling the products away from each other. A dependent claim details that the 2-methyl-3-butenitrile is generated by hydrocyanation of 1,3-butadiene and separating the reaction products by distillation.

Drinkard et al. teach the isomerization of 2-methyl-3-butenitrile over a tetrakis(triethyl phosphite) nickel(0) catalyst in order to generate 3-pentenenitrile. See column 4, Example 1.

Drinkard et al. do not teach where the product nitriles are separated from each other by distillation and where the reactant stream comes from the hydrocyanation of 1,3-butadiene.

Fischer et al. teach the hydrocyanation reaction of 1,3-butadiene with a nickel phosphite catalyst to form pentenenitriles which include 2-methyl-3-butenitrile. See Example 15, column 21.

Jungkamp et al. teach the azeotropic distillation of various pentenenitrile isomers with the pressures and temperatures required by the claims. See page 2, line 39 through page 3, line 6 and Table 1, page 7. Jungkamp et al. do not teach the exact pairs of isomers that are listed in claim 1 nor does Jungkamp et al. teach the exact reactions that the mixtures come from.

It would be obvious to one of ordinary skill to take the method proven by Jungkamp et al. and apply it to other mixtures of pentenenitrile isomers as distillation techniques such as simple distillation, fractional distillation, vacuum distillation, and azeotropic distillation are well known in the art and are readily applied by the person of

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ordinary skill in purifying isomeric liquids from one another. As to the reaction that the mixtures come from, one of skill in the art would be able to complete the distillation irrespective for which reaction the mixture of pentenenitriles originated from.

Therefore the claims are *prima facie* obvious over the prior art.

Conclusion

Claims 1-10 and 17-20 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Kosack whose telephone number is (571)272-5575. The examiner can normally be reached on M-Th 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Joseph R Kosack/
Primary Examiner, Art Unit 1626